

Appl. No. 09/466,124

## **REMARKS/ARGUMENTS**

### **Status of Claims**

Claims 1-43 remain in the application. Claims 3, 4, 6, 7, 9, 10, 13-20, 24, 25, 29, 32-35, 37, 38, 41 & 42 were indicated as being allowable if amended to include features of the claims from which they depend. The remaining claims were rejected under 35 USC §102 or 103.

### **Amendments to Claims**

Claim 22 has been amended by adding the limitation "through the respective maintained communication links of the first mobile station and the second mobile station". The limitation is the same limitation found in claims 1, 11, 12, 28, 36 and 40.

### **35 U.S.C 102 Claim Rejections**

The Examiner has rejected claims 1, 2, 5, 8, 11, 12, 21-23, 27, 28, 30, 36, 39, 40 and 43 under 35 U.S.C. 102(e) as being anticipated by United States Patent No. 6,405,050 (Amirijoo).

Controlling case law has frequently addressed rejections under 35 U.S.C. § 102. "For a prior art reference to anticipate in terms of 35 U.S.C. Section 102, every element of the claimed invention must be identically shown in a single reference." Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 677, 7 U.S.P.Q.2d 1315, 1317 (Fed. Cir. 1988; emphasis added). The disclosed elements must be arranged as in the claim under review. See Lindemann Machinefabrik v. American Hoist & Derrick Co., 730 F.2d 1452, 1458, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984). If any claim, element, or step is absent from the reference that is being relied upon, there is no anticipation. Kloster Speedsteel AB v. Crucible, Inc., 793 F.2d 1565, 230 U.S.P.Q. 81 (Fed. Cir. 1986; emphasis added). The following analysis of the present rejections is respectfully offered with guidance from the foregoing controlling case law decisions.

Amirijoo does not identically disclose an apparatus having all the functionality recited in the claims as required by case law. For example, claim 1 of the present application recites "an apparatus for controlling data unit communications between a plurality of mobile stations". It is

Appl. No. 09/466,124

the apparatus that comprises the “means for grouping”, “means for determining” and “means for enabling communication”. An example of this apparatus is the Radio Network Controller (RNC) 24 in Figures 1 and 2 of the subject application. While Amirjoo discloses a wireless system generally (i.e., one that it includes mobile terminals, base transceiver stations (BTS), and base station controllers (BSC) which occur between the BTS and mobile switching center (MSC)), differences exist, as will be explained below.

As will be discussed in detail below, the Examiner has equated the “means for determining” with functionality occurring in the mobile station as disclosed at column 6, lines 49-60 of Amirjoo. The functionality of the mobile stations is not relevant in objecting to the claims because the claims recite that the apparatus is in contact with “each of the mobile stations”. Therefore, the apparatus is not considered to be one of the plurality of mobile stations - they are mutually exclusive. In addition, Amirjoo does not disclose that any of the MSC, BSC, or BTS has all of the “means for grouping”, “means for determining” and “means for enabling communication” as recited by the claims.

With regard to claims 1, 11, 12, 22, 28, 36 and 40, the Examiner alleges that Amirjoo discloses “an apparatus for controlling data unit communications between a plurality of mobile stations, each of the mobile stations having a respective maintained communication link with the apparatus, the apparatus comprising...means for enabling communication of the data unit from the first mobile station to the second mobile station through the respective maintained communication links of the first mobile station and the second mobile station only if they are both members of the private network group”.

The Examiner equates “each of the mobile stations having a respective maintained communication link” recited in claim 1 with a notification message being continuously transmitted to the mobile stations in the group disclosed in Amirjoo at column 5, lines 11-18. The Examiner equates “means for enabling communication of the data unit from the first mobile station to the second mobile station through the respective maintained communication links of the first mobile station and the second mobile station only if they are both members of the private network group” with the disclosure made by Amirjoo at column 2, lines 24-35.

Appl. No. 09/466,124

Amirijoo discloses a system in which there are at least two different types of communication links used for communication from between mobile stations and the MSC. A first communication link is a control channel for transmitting a notification message to notify group members of a group call and identify the group call channel, as described in column 4, lines 19-21. The present application describes "a very low bandwidth connection can be permanently maintained between a mobile station and its corresponding BTS" page 12, lines 19-20, whereas Amirijoo describes at column 1, lines 33-35, "within each of cell of the group call area, a notification message is transmitted to each mobile station in the cell over a control channel" (emphasis added). Applicant submits that the control channel is a broadcast channel common to all mobile stations, not "a respective maintained communication link" between each mobile station and the apparatus for controlling data communication as recited in claim 1. A second communication channel is a traffic channel, which is used for communication traffic by the respective mobile stations only after the notification message has been received and the mobile station has identified that there is a call to be received on the traffic channel. As described at column 4, lines 21-23, "After receiving the notification message, the MS (mobile station) 20 belonging to group members can tune to the channel specified in the notification message the group call channel". As Amirijoo discloses utilizing a group call channel that "group members can tune to" only after they have received the notification message which specifies the channel, Applicant submits that this is not the same as "a respective maintained communication link" as recited in the present claims.

Amirijoo does not disclose "means for enabling communication of the data unit from the first mobile station to the second mobile station through the respective maintained communication links of the first mobile station and the second mobile station" (emphasis added) as recited in claim 1 because Amirijoo does not disclose enabling communication on the same "maintained communication link". Amirijoo discloses the traffic channel is a group call channel. Group call channels of each BSC are bridged together as one signal at the MSC (column 4, lines 24-25). Applicant submits that a group call channel at least for each BSC is a common channel used by all group members, which is not the same as each of the mobile stations having a respective maintained communication link.

Appl. No. 09/466,124

Communication in Amirijoo comprises both the notification message transmitted on the control channel and the traffic transmitted on the traffic channel. As the traffic channel is not a maintained communication link, and is in fact a different channel than the control channel, Amirijoo does not disclose an apparatus in which each mobile station has a respective maintained communication link and "means for enabling communication of the data unit from the first mobile station to the second mobile station through the respective maintained communication links of the first mobile station and the second mobile station".

The Examiner also equates "means for determining if a first mobile station sending a data unit and a second mobile station scheduled to receive the data unit are both members of the private network group" with the mobile unit detecting if it is part of a group identified by a received group identification number sent in a notification message as recited at column 6, lines 49-60. Clearly from this description Amirijoo is disclosing that it is the mobile station itself determining whether it is a member of a group, as opposed to the apparatus for controlling data unit communications determining if a sending mobile station and a receiving mobile station are both members of a private network group. There is no indication in Amirijoo of an apparatus that specifically determines whether a sending and/or receiving mobile station is a part of a group. While the receiving mobile station is disclosed as being capable of determining whether it is a member of a group, there is no suggestion that it provides this information to any other device, for example an apparatus for controlling data unit communications. Therefore, Applicant submits that Amirijoo does not disclose "an apparatus for controlling data unit communications ...comprising...means for determining if a first mobile station sending a data unit and a second mobile station scheduled to receive the data unit are both members of the private network group".

For at least the above discussed reasons, Amirijoo does not disclose an apparatus having all the features recited in claim 1 and as such cannot be held to anticipate claim 1. Applicant respectfully requests that the Examiner withdraw the rejection of claim 1.

Claims 11, 12, 28, 36 and 40 and amended claim 22 recite similar subject matter to claim 1. For the same reasons described above with regard to claim 1, Applicant submits that

Appl. No. 09/466,124

Amirijoo does not disclose all the features of claims. It is respectfully requested the Examiner withdraw the objection to claims 11, 12, 22, 28, 36 and 40.

Claims 2, 5 and 8 are dependent on claim 1. Claim 21 is dependent on claim 12. Claims 23 and 27 are dependent on claim 22. Claim 30 is dependent on claim 28. Claim 39 is dependent on claim 36. Claim 43 is dependent on claim 40. For at least the same reasons discussed above with regard to claims 1, 12, 22, 28, 36 and 40, Applicant submits that claims 2, 5, 8, 21, 23, 27 30, 39 and 43 are not anticipated by Amirijoo. It is respectfully requested that the Examiner withdraw the objection to these claims.

### **35 U.S.C 103 Claim Rejections**

The Examiner has rejected claim 26 under 35 U.S.C. 103(a) as being unpatentable over Amirijoo in view of U.S. Patent No. 6,549,768 (Fraccaroli).

The requirements for establishing a prima facie case of obviousness as set out in the MPEP Section 2143.01 require that the reference or references when combined teach all of the claimed limitations, that there be a reasonable expectation of success in realizing the claimed invention, and that there be a motivation to combine the references.

Claim 26 is dependent upon claim 22. The Examiner alleges that while the Amirijoo reference discloses the subject matter of claim 22, it does not disclose the additional feature of "at least one of the plurality of apparatus is an intelligent peripheral coupled within a third generation wireless network". However, it is alleged that Fraccaroli discloses this feature, as described at column 6, lines 45-59.

On page 10, lines 11-12 of the present application, the description states that an example of an intelligent peripheral is a server. On page 11, lines 18-26, the intelligent peripheral is further described as "designed to control service features that are available to the mobile station within the cell cluster. Further, the intelligent peripheral 22 maintains a registry of all the mobile stations assigned to the MSC 20 by maintaining a database with all their HLRs". Fraccaroli discloses that 3<sup>rd</sup> generation handsets are expected to include a capability of providing information about the user's location and thus facilitate mobile-based positioning. Fraccaroli

Appl. No. 09/466,124

does not disclose a peripheral with the capabilities described in the present application. Fraccaroli instead discloses a 3<sup>rd</sup> generation handset having functionality unrelated to the functionality of Applicant's intelligent peripheral.

For at least the reasons discussed above in the 35 U.S.C 102 Claim Rejections section, Amirijoo does not disclose all the features of claim 22, which claim 26 is dependent upon, as alleged by the Examiner. Furthermore, as discussed above Fraccacoli does not disclose the further limitation recited in claim 26. Applicant submits that for at least these reasons the Examiner has failed to satisfy the necessary requirement that the cited references must teach all the limitations of the claim. Therefore, the Examiner has failed to satisfy at least one of the requirements for establishing a *prima facie* case of obviousness. It is respectfully requested that the Examiner reconsider and withdraw the rejection of claim 26.

The Examiner has rejected claim 31 under 35 U.S.C. 103(a) as being unpatentable over Amirijoo in view of U.S. Patent No. 6,249,584 (Hamalainen).

Claim 31 is dependent upon claim 28. For at least the reasons discussed above in the 35 U.S.C 102 Claim Rejections section, Amirijoo does not disclose all the features of claim 28, which claim 31 is dependent upon, as alleged by the Examiner. Applicant submits that for at least these reasons the Examiner has failed to satisfy the necessary requirement that the cited references must teach all the limitations of the claim. Therefore, the Examiner has failed to satisfy at least this one requirement for establishing a *prima facie* case of obviousness.

Furthermore, according to The Manual of Patent Examining Procedure, Section 2143.01 "there are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art". It is respectfully submitted that the Examiner has not established a motivation to combine the references from any of the three sources.

With regard to the first source for a motivation to combine, Applicant submits that the nature of the problem to be solved is not the same in the two references as is made evident by the fact that the U.S. and International classifications are different for the two references as well as the majority of the Fields of Search. Amirijoo teaches a system method and apparatus for

Appl. No. 09/466,124

transmitting group calls and Hamalainen discloses a method for indicating enciphering of data transmission between a mobile communication network and a mobile station in the mobile communication network.

With regard to the second source for a motivation to combine, Applicant submits that neither of the two pieces of cited art suggest the subject matter of the other piece of prior art in a manner that would lead one skilled in the art to arrive at the claimed invention by a review of the two references. In addition, neither reference refers to the other. Furthermore, the respective prior art does not suggest either alone or in combination the desirability of the claimed invention. As was clearly stated *In re Kotzab*, 55 USPQ2d 1313, 1318 "Identification of prior art statements that, in abstract, appear to suggest claimed limitation does not establish prima facie obviousness without a finding as to specific understanding or principle within knowledge of skilled artisan that would have motivated one with no knowledge of invention at issue to make combination in manner claimed" (emphasis added). Applicant respectfully submits that the teachings the Examiner has selected in Hamalainen to combine with Amirijoo are a prime example of "identification of prior art statements that, in abstract, appear to suggest claimed limitation", but clearly do not result in the invention in the manner claimed.

With regard to the third source for a motivation to combine, Applicant submits that the Examiner has failed to show motivation based on the knowledge of persons of ordinary skill in the art. The Examiner has stated that a motivation for combining the two references is "that it provides the added feature of connecting a personal computer or data terminal into the wireless network of Amirijoo". There is no clear indication in this statement of motivation that suggests why a person skilled in the art would look to Amirijoo, which is directed to transmission and receiving of voice in group calls and then look to Hamalainen, which deals with enciphering data to arrive at the recited invention.

Therefore, the Examiner has failed to satisfy a second of the three requirements for establishing a prima facie case of obviousness.

As the Examiner has failed to satisfy at least two of the three necessary criteria for establishing a prima facie case of obviousness with respect to claim 31, for at least the reasons

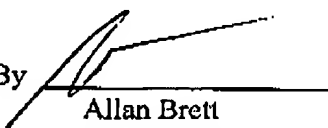
Appl. No. 09/466,124

discussed above, Applicant submits that claim 31 patentably distinguishes over the combination of Amirjoo and Hamalainen. It is respectfully requested that the Examiner reconsider and withdraw the obviousness rejection of claim 31.

In view of the forgoing, early favourable consideration of this application is earnestly solicited.

Respectfully submitted,

By

  
Allan Brett  
Reg. No. 40,476  
Smart & Biggar

Date: January 27, 2006  
RAB:MSS:mcg  
Ottawa, Ontario, Canada  
Tel.: 613-232-2486



**This Page is Inserted by IFW Indexing and Scanning  
Operations and is not part of the Official Record**

**BEST AVAILABLE IMAGES**

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ **BLACK BORDERS**
- ☐ **IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- ☐ **FADED TEXT OR DRAWING**
- ☐ **BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- ☐ **SKEWED/SLANTED IMAGES**
- ☐ **COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- ☐ **GRAY SCALE DOCUMENTS**
- ☒ **LINES OR MARKS ON ORIGINAL DOCUMENT**
- ☐ **REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- ☐ **OTHER:** \_\_\_\_\_

**IMAGES ARE BEST AVAILABLE COPY.**

**As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.**